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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/976,159 11/21/97 BRANDER

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EXAMINER

KENYON & KENYON
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NEW YORK NY 10004

ROMAIN, J

ART UNIT	PAPER NUMBER
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2765

DATE MAILED:

07/29/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/976,159

Applicant(s)
Brander et al.

Examiner
Romain Jeanty

Group Art Unit
2765



☒ Responsive to communication(s) filed on May 14, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2765

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112

1. Claims 4 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claim 4 recites the limitation " records for the internal customer account numbers" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 U.S.C. § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Securities and Exchange Commission Proposed Rule Change, Depository Trust

Art Unit: 2765

Company, filed with SEC on form 19b-4 in file SR-DTC-93-07, pp. 1-72) in view of Hawkins et al. (Patent No. 5,497,317).

As per claims 1, 12, 21, 22, 29, 31, THE DEPOSITORY TRUST COMPANY discloses:

a system for settlement of a securities trade by obtaining agreement as to the details of the trade among a broker, institution, agent and interested parties comprising:

a. A broker, institution, agent and interested parties to send and receive communications (Page 3 of 72, lines 1-8).

b. A standing instruction database containing sets of instructions for trade settlement previously input by the institution, the broker and the agent (Page 3 of 72, lines 4-8).).

c. Standing instructions database (Page 3 of 72, lines 4-6) which is configured to :

i. Receive a communication from the broker containing notice of order execution information (Page 3 of 72, lines 20-22).

ii. Receive a communication from the institution containing institution allocation institution information (Page 3 of 72, lines 22-26).

Art Unit: 2765

iii. Match, the institution communication with the broker communication based on information contained in both communications (Page 4 of 72, lines 14-16).

iv. If there is a match, generate a confirmation for the trade based on information contained in the broker communication, information contained in the institution communication and information stored in the standing instructions database (Page 20 of 72, lines 5-10).

v. Make available the confirmation as a communication to the institution, broker, agent and interested parties which facilitates the exchange of money and securities to settle the trade (Page 20 of 72, lines 9-11).

THE DEPOSITORY TRUST COMPANY discloses all of the limitations above, but fails to disclose a processing computer. But, Hawkins et al. disclose the use of a computer system and a computer processor Column 4, lines 65-66; Column 5, lines 1-5). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to combine the disclosure of THE DEPOSITORY TRUST COMPANY with Hawkins et al. One would have been motivated to this combination because it would provide with the capability to automate the system by making the system run faster, thereby providing better communication services to users of the system.

Art Unit: 2765

As per claims 2, 16, 17, 19, and 23, THE DEPOSITORY TRUST COMPANY discloses the system of claim 1 where the broker communication and the institution communication each contain the data fields of:

an institution identification number, a broker identification number, a security identification number, a buy/sell code, a number of shares or face value, a settlement amount (Page 35 paragraph number 4).

As per claim 3 and 24, THE DEPOSITORY TRUST COMPANY explicitly fails to disclose a unique identification. Hawkins et al. discloses a unique identification number (Column 5, lines 26-32). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include a unique identification with the data associated with participants of the system. One would have been motivated to combine THE DEPOSITORY TRUST COMPANY with Hawkins et al. because this combination would implement the matching of information process among participants of the system.

As per claim 5 and 25, THE DEPOSITORY TRUST COMPANY discloses an institution communication both contain a data field indicating a settlement amount for the trade, the institution communication additionally

Art Unit: 2765

contains a tolerance data field which specifies a tolerance value by which a match based on settlement amount could vary and the processing computer matches the broker communication and the institution communication so long as the settlement amounts vary only by an amount within the tolerance (Page 36, last paragraph: Page 51, last 4 paragraphs).

As per claim 6, THE DEPOSITORY TRUST COMPANY discloses a system in which the institution communication contains a data field which indicates that the institution is the affirming party for the trade and the processing computer generates a confirmation which contains this indication in a data field (Page 52, last two paragraphs)

As per claims 7, 8, 27, 28 and 32, Official notice is taken that storing and retrieving information in a database is old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to store and retrieve information in a database prior to making a match for the purpose of updating the database.

As per claims 9, 10 and 11, THE DEPOSITORY TRUST COMPANY discloses:

Art Unit: 2765

Receive a communication from the broker comprising data fields with information concerning the executed trade (Page 3 of 72, lines 20-22; Page 50, fourth paragraph), and receive a communication from the comprising data fields with information concerning the executed trade (, where some of the data fields within the institution communication corresponding to the data fields within the broker communication (Page 3 of 72, lines 22-26), and match the broker communication and the institution communication matching the data within a preselected set of the corresponding data fields (Page 4 of 72, lines 14-16).

THE DEPOSITORY TRUST COMPANY discloses all of the limitations above, but fails to disclose a processing computer. But, Hawkins et al. disclose the use of a computer system and a computer processor Column 4, lines 65-66; Column 5, lines 1-5). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to combine the disclosure of THE DEPOSITORY TRUST COMPANY with Hawkins et al. One would have been motivated to this combination because it would provide with the capability to automate the system by making the system run faster, thereby providing better communication services to users of the system.

As per claim 13, THE DEPOSITORY TRUST COMPANY discloses:

Art Unit: 2765

a broker communication containing data within data fields designated by:

a. An institution identification number, a broker identification number, a security identification number, a buy/sell code, a number of shares or face value, a settlement amount, trade date, and trade settlement date (Page 35 paragraph number 4).

b. An institution communication containing data within data fields designated by:

An institution identification number, a broker identification number, a security identification number, a buy/sell code, a number of shares or face value, a settlement amount (Page 35 paragraph number 4).

Compare (match), the institution communication with the broker communication based on information contained in both communications (Page 4 of 72, lines 14-16; Page 20 of 72, lines 5-10).

iv. If there is a match, generate a confirmation for the trade based on information contained in the broker communication, information contained in the institution communication and information stored in the standing instructions database (Page 20 of 72, lines 5-10).

THE DEPOSITORY TRUST COMPANY discloses all of the limitations above, but fails to disclose a processing computer. But, Hawkins et al. disclose the use of a computer system and a computer processor Column 4, lines 65-66;

Art Unit: 2765

Column 5, lines 1-5). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to combine the disclosure of THE DEPOSITORY TRUST COMPANY with Hawkins et al. One would have been motivated to this combination because it would provide with the capability to automate the system by making the system run faster, thereby providing better communication services to users of the system.

As per claim 14, THE DEPOSITORY TRUST COMPANY discloses:

- a. A trade confirmation communications system comprised to receive, process and transmit communications from and to the parties(.
- b. A standing instructions data base (coupled to the trade confirmation communications system having at least one data table (for storing a plurality of information related to the trade stored by at least one of the parties (Page 3, lines 4-8; Page 50, fourth paragraph).
- c. Receive a trade communication containing order execution information from one of the parties and receiving information concerning a trade allocation information from an other one of the parties (Page 3, lines 20-26); and
- d. The trade communications system further comprised to generate a confirmation based on information within the received communication and

Art Unit: 2765

information stored within the standing instruction database (Page 20, lines 9-11).

THE DEPOSITORY TRUST COMPANY discloses all of the limitations above, but fails to disclose a matching controller. But, Official notice is taken that matching controllers are old and well known in the art to have been used for the purpose of matching communication between different parties in communication system.

As per claim 15, it is inherent to have a datatable for each participants of the trading system.

As per claim 20, it is inherent for the data storage table to have the names and addresses all parties involved in the trade.

As per claims 32-33, 35-36, it is inherent for information in the confirmation to be used as settlement instructions by at least one participants in a trading transactions.

Conclusion

Art Unit: 2765


5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached on weekdays from 8:00 a.m to 4:30 p.m.

If attempts to reach the examiner are not successful, the examiner's supervisor, Allen R. MacDonald, can be reached at (703) 305-9708. The fax number for this group is (703) 305-5397.

Romain Jeanty


ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER
11/22/08